

**Amendments To The Drawings**

An attached drawing sheet includes Figure 3, and replaces the original sheet including Figure 3. As required by the Examiner, and in accord with 37 C.F.R. §1.83(a), Applicants have amended Figure 3 to add labels to elements designated by reference numerals 202, 204, 302, 304, 306, 308, 310, 312, 314, 324, and 326. To avoid the introduction of any new matter, the added labels are based on terminology used in the specification.

Attachment: Replacement Drawing Sheet 3

## **REMARKS**

Figure 3 has been amended, Claims 2–5, 7–12, 14–17, and 19–20 have been amended, and Claims 1 and 13 have been canceled. Claims 2–5, 7–12, 14–17, and 19–20 are currently present in this application. In view of the foregoing amendments, and the remarks that follow, Applicants respectfully request reconsideration.

### **Comment Regarding Claim 20**

Claim 20 depended from Claim 18, but Claim 18 was canceled in a prior Amendment. Claim 20 should have depended from Claim 19, and the foregoing claim amendments modify Claim 20 so that it correctly depends from pending Claim 19 rather than canceled Claim 18.

### **Drawing Objection**

The Office Action objects to the drawings, specifically stating on page 3 that “Figure 3 is missing labels for each element.” As required by the Examiner, and in accord with 37 C.F.R. §1.83(a), Applicants have amended Figure 3 to add labels to elements designated by reference numerals 202, 204, 302, 304, 306, 308, 310, 312, 314, 324, and 326. To avoid the introduction of any new matter, the added labels are based on terminology used in the specification. Accordingly, Applicants respectfully request notice that the drawing objection be withdrawn.

### **Compliance With 35 U.S.C. §101**

Claims 16–18 are rejected under 35 U.S.C. §101 as directed to non-statutory subject matter. More specifically, the Office Action asserts on page 3 that the recitation of a “computer readable medium” enables the claims to “encompass a software-only embodiment”, that software “does not fall within any of the statutory categories”, and that “[t]he medium must be clearly hardware only.” Applicants note that Claim 18 was previously canceled, and so the rejection of Claim 18 is moot. Claim 16 previously depended from Claim 13. The foregoing amendments add the limitations of Claim 13 to Claim 16, in order to convert Claim 16 from dependent form into independent form, without changing the scope of Claim 16.

Applicants respectfully traverse the rejection of Claims 16 and 17. Claim 16 recites a “computer readable medium comprising a plurality of instructions for execution by at least one computer processor.” MPEP §2106.01(I) specifies that “a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program’s functionality to be realized, and is thus statutory.” See *In re Beauregard*, 53 F.3d 1583 (Fed. Cir. 1995) and *In re Lowry*, 32 F.3d 1579, 1583-84 (Fed. Cir. 1994). Thus, and contrary to the assertions in the Office Action, Claim 16 recites statutory subject matter under §101. Claim 17 has been amended to depend from Claim 16. Accordingly, Applicants respectfully request that the §101 rejection of Claims 16 and 17 be withdrawn.

#### Compliance With the First Paragraph of 35 U.S.C. §112

On page 4, the Office Action rejects “claims” under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. Applicants respectfully traverse this rejection. The Examiner asserts that the recitation in Claim 1 of “denying the first router any access to the second network” is not supported in the specification, and specifically states on page 4 that “[t]here is no mention of one router denying access to another router, and how this is performed.” The Examiner also asserts on page 2 that “Applicants specifications fails to support the amended limitation of ‘denying the first router any access to the second router’.” Aside from this mention of Claim 1, it is not clear which “claims” are rejected under §112, and Applicants assume, for purposes of responding to the Office Action, that the Examiner has rejected only Claim 1 under 35 U.S.C. §112, first paragraph.

Claim 4 previously depended from Claim 1. The foregoing amendments add the limitations of Claim 1 to Claim 4, in order to convert Claim 4 from dependent form into independent form. Thus, Claim 4 now recites the limitation addressed by the Office Action under the §112 rejection.

Applicants first note that Claim 4 recites “denying the first router any access to the second network” (emphasis added), not denying access to a second router as the Examiner

In addition, originally-filed Figure 3 of the present application is reproduced below:



8

For the foregoing reasons, Applicants respectfully submit that the recitation in Claim 4 of “denying the first router any access to the second network” is fully supported by the present application as originally filed (including the specification and drawings). Applicants respectfully submit that the §112, second paragraph, rejection should be withdrawn, and notice to that effect is respectfully requested.

#### Support for Prior Claim Amendments

On page 2 of the Office Action, in regard to claim amendments made in Applicants' last Response, the Examiner has requested that Applicants indicate where new/amended claim limitations have support in the specification, with a citation to MPEP §§2163.03(I), 2163.04(I), 2163.06. First, Applicants respectfully note that Applicants are not required to provide support for newly added or amended claims. In fact, MPEP §2163 does not apply here. MPEP §2163.06(I) relates to a different type of situation where an applicant is encouraged, but not required, to demonstrate support, as follows:

When an amendment is filed in reply to an objection or rejection based on 35 U.S.C. 112, first paragraph, a study of the entire application is often necessary to determine whether or not “new matter” is involved. Applicant should therefore specifically point out the support for any amendments made to the disclosure.

But here, Applicants did not add the language “denying the first router any access to the second network” by amendment, much less in response to a 35 U.S.C. §112, first paragraph rejection. This language was already present in the claims. In any event, as discussed above in the preceding section of these remarks, the present application clearly provides support for this claim language. Accordingly, Applicants respectfully submit that the originally-filed application papers provide support for the claim limitation in question.

Independent Claim 4

As discussed above, Claim 4 previously depended from Claim 1. The foregoing amendments add the limitations of Claim 1 to Claim 4, in order to convert Claim 4 from dependent form into independent form. These amendments do not make any change to the scope of Claim 4.

The Office Action rejected Claim 4 under 35 U.S.C. §103 on the ground that it would be obvious to modify Myers U.S. Patent Application Publication No. 2004/0122956 in view of Kim U.S. Patent Application Publication No. 2005/0005110 and Hericourt U.S. Patent No. 6,792,461. However, this ground of rejection is respectfully traversed. In this regard, the PTO specifies in MPEP §2142 that:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

Applicants respectfully submit that the teachings drawn from Myers, Kim, and Hericourt fail to establish a *prima facie* case of obviousness under §103 with respect to Claim 4, for the following reasons.

**NO VALID REASON IS GIVEN FOR MODIFYING MYERS IN VIEW OF HERICOURT**

The requirements for properly establishing a *prima facie* case of obviousness are discussed in MPEP §2142, which emphasizes that:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. \_\_\_, \_\_\_, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under

35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that “rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F. 3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. at \_\_\_, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval).

Claim 4 of this application includes a recitation of “routing to a proxy server through the first router.” The Examiner admits on page 8 of the Office Action that “Myers and Kim fail to explicitly teach routing to a proxy server through the first router.” The Examiner therefore turns to *Hericourt*, stating on page 9 that:

*Hericourt* discloses routing to a proxy server through a router where the proxy server is connected to the Internet . . . , and *Hericourt* teaches that the proxy servers are utilized for the purpose of locally caching HTTP data from the Internet and providing the cached data to a workstation that sends a request for that particular HTTP data . . . .

The Examiner asserts that it would be obvious to modify Myers view of *Hericourt* so that the system of Myers can cache data. Specifically, on page 9 of the Office Action, the Examiner proposes the following reason or “motivation” for making the proposed modification to Myers in view of *Hericourt*:

It would have been obvious for one of ordinary skill in the art to modify Myers and Kim by routing to a proxy server through the first router as per the teachings of *Hericourt*. One would be motivated to do so for the purpose of utilizing the proxy servers as cache servers in order to locally cache HTTP data from the

Internet and then provide it to a workstation that sends a request for that particular HTTP data, and which increases efficiency.

However, this reasoning is flawed. First, in lines 9-10 of column 4, Hericourt expressly defines a proxy server to be “a special server that allows access to the Internet”. But Myers and Kim both disclose allowing a user access to the Internet. One of ordinary skill in the art would not be motivated to combine Hericourt’s proxy server with Myers to facilitate Internet access, because such access is already achieved in the Myers system.

Second, the Examiner’s proposed reason for modifying Myers in view of Hericourt begins from the premise that the system of Myers fails to provide for caching data. However, this premise is not correct. At the time the present application was filed, local caching of Internet data was very well known in the art. Caching data is performed in a number of ways including the use of web caches (for example, employed by web browsers), and other suitable caching mechanisms. One of ordinary skill in the art would readily recognize that the system of Myers is entirely capable of caching Internet data without the use of Hericourt’s proxy server. For example, Myers provides in paragraphs [0041] and [0051] that “mobile units 30 associated with customers and partners are provided access to the Internet 56,” and the mobile units can be “a laptop, personal digital assistant (PDA) or other device.” Kim provides in paragraph [0022] that “computers 100 are equipped with communications software, including a WWW browser.” One of ordinary skill in the art would recognize that the mobile units 30 of Myers and the computers 100 of Kim presumably already provide Internet caching (for example via standard web browsers utilized to access the Internet), thereby making it unnecessary to add a proxy server for the purpose of performing these caching functions. Accordingly, the motivation proposed by the Examiner is not sufficient to support a *prima facie* case of obviousness, because it would not actually motivate a person of ordinary skill to make the proposed modification to Myers.

Consequently, it appears that the idea to modify Myers in view of Hericourt is not coming from what was known before the present invention, but instead is necessarily coming



from hindsight of Applicants' disclosure. In particular, using Applicants' disclosure as a blueprint, the Examiner has selectively extracted isolated features from Myers, Kim, and Hericourt, and has then combined these isolated features with a 20/20 hindsight view of the desired result. However, the proper inquiry is whether, if Applicants' disclosure is completely ignored, there is any reason that would prompt a person of ordinary skill to make the proposed modification of Myers in view of Kim and Hericourt. Here, since a person of ordinary skill in the art would recognize that the system of Myers is apparently already capable of efficiently caching data, the Examiner has not identified any valid reason that would prompt the proposed modification of Myers to add the proxy server of Hericourt.

In view of the reasons discussed above, it is respectfully submitted that the Examiner has failed to properly establish a *prima facie* case of §103 obviousness for Claim 4 based on Myers, Kim, and Hericourt. Claim 4 is therefore believed to be allowable, and notice to that effect is respectfully requested.

#### Independent Claim 16

As noted above, Claim 16 previously depended from Claim 13, and the foregoing amendments add the limitations of Claim 13 to Claim 16, in order to convert Claim 16 from dependent form into independent form. These amendments do not make any change to the scope of Claim 16.

The Office Action rejected Claim 16 under 35 U.S.C. §103 on the ground that it would be obvious in view of a proposed modification to Myers in view of Kim and Hericourt. Applicants respectfully traverse this rejection. The rationale given in the Office Action for this rejection of Claim 16 is precisely the same rationale given for the rejection of Claim 4. Therefore, for reasons similar to those discussed above in association with Claim 4, it is respectfully submitted that Claim 16 is not rendered obvious under §103 by Myers in view of Kim and Hericourt. Claim 16 is believed to be allowable, and notice to that effect is respectfully requested.

### Independent Claim 19

The Office Action rejected Claim 19 under 35 U.S.C. §103 on the ground that it would be obvious in view of a proposed modification of Myers in view of Kim. Applicants respectfully traverse this rejection. Claim 19 has been amended, and now includes a recitation of “a first router for serving the first access point and routing the first computing device to a proxy server for providing access to the Internet.” For reasons similar to those discussed above in association with Claims 4 and 16, it is respectfully submitted that amended Claim 19 is not rendered obvious under §103 by Myers in view of Kim (or in view of Kim and Hericourt). Claim 19 is thus believed to be allowable, and notice to that effect is respectfully requested.

### Dependent Claims

Claims 2–3, 5, and 7–12, Claims 14–15 and 17, and Claim 20 respectively depend from Claim 4, Claim 16, and Claim 19, and are also believed to be allowable over the art of record, for example for the same reasons discussed above in association with Claims 4, 16, and 19, respectively.

### Conclusion

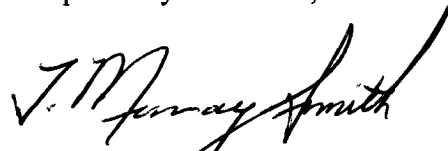
Based on the foregoing, it is respectfully submitted that all of the pending claims are fully allowable, and favorable reconsideration of this application is therefore respectfully requested. If the Examiner believes that examination of the present application may be advanced in any way by a telephone conference, the Examiner is invited to telephone the undersigned attorney at (972) 739-8647.

Appl. No. 10/806,967  
Response to Office Action dated January 14, 2009

Attorney Docket No. 2003-0571 / 24061.112  
Customer No. 42717

Although Applicants believe that no additional fee is due, the Commissioner is hereby authorized to charge any fees required by this paper, or to credit any overpayment, to Deposit Account No. 08-1394 of Haynes and Boone, LLP.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "T. Murray Smith", written over a horizontal line.

T. Murray Smith  
Registration No. 30,222  
(972) 739-8647

Date: April 16, 2009

HAYNES AND BOONE, LLP  
IP Section, Suite 700  
2323 Victory Avenue  
Dallas, Texas 75219  
Telephone: (972) 680-7550  
Facsimile: (214) 200-0853  
File: 24061.112

Enclosures: Replacement Drawing Sheet 3  
Petition for Time Extension (One Month)

R-225959.1